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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09-986,630	11-09-2001	Haruaki Sue	TM&K 0014	5947

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EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 05/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,030

Applicant(s)

CHANG ET AL.

Examiner

Robert Sellers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 13 December 2001 and 11 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 7-9, 11-14, 17, 18, 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 23-28 is/are allowed.
- 6) ☐ Claim(s) 1-6, 10, 15, 16, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/318,487.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 5
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, 10, 15, 16, 19, 20 and 23-28, drawn to an arylcyclopentylaryl polyepoxide of general formula (I) wherein the arylcyclopentyl repeating unit quantified by "m" is zero as limited in claims 23-28, classified in class 549, subclass 522.
- II. Claims 1-5, 10 and 15-22, drawn to an arylcyclopentylaryl polyepoxide cooligomer of general formula (I) wherein the arylcyclopentyl repeating unit quantified by "m" is a positive number as limited in claims 17, 18 and 21, classified in class 528, subclass 98.
- III. Claims 7-9, 11 and 12, drawn to an arylcyclopentylaryl polyepoxide and a curing agent, classified in class 525, subclass 481.
- IV. Claim 13, drawn to a resin-encapsulated electronic device, classified in class 257, subclass 793.
- V. Claim 14, drawn to an arylcyclopentylaryl polyepoxide wherein the Ar² group of the arylcyclopentyl repeating unit further comprises a phenolic moiety, classified in class 525, subclass 523.

Claim 6 has been included with Invention I because the arylcyclopentylaryl polyepoxide of general formula (II) is encompassed by the arylcyclopentylaryl polyepoxide of general formula (I) wherein m is zero.

Claim 10 is inserted into Inventions I and II since the same general formula (I) as claim 1 is depicted wherein the ultimated intended utility as a "material for encapsulating electronic devices" is denoted.

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The inventions are distinct from each other because:

The arylcyclopentylaryl polyepoxide of general formula (I) of Invention I wherein the arylcyclopentyl repeating unit is zero defines a compound, whereas that of Invention II in which the repeating unit is a positive number indicates a cooligomer which is structurally distinct and contains a different amount of epoxy groups.

The presence of the additional phenolic group in the Ar² substituent of Invention V introduces a functionally diverse reactive group which materially affects the characteristics of the final product and therefore is structurally different from the arylcyclopentylaryl polyepoxides of Inventions I and II.

Inventions (I or II or V) and (III or IV) are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an adhesive and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.

Inventions III and IV are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a coating and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

This application contains claims directed to the following patentably distinct species of the claimed invention:

The Ar² of general formula (I) or (II).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-28 are generic.

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A reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Joerg-Uwe Szipl on April 22, 2003, a provisional election was made with traverse to prosecute the invention of Group I and the arylcyclopentylaryl polyepoxide of claim 24, claims 1-6, 10, 15-24 and 26-28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-9 and 11-14, 17, 18, 21 and 22 are withdrawn from further consideration under 37 CFR 1.142(b) as being drawn to non-elected inventions. Claim 25 is withdrawn as being directed to a non-elected species of arylcyclopentylaryl polyepoxide.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 6 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5, page 56, line 9 denotes the language "selected from the group selected from" and on page 58, lines 1-2 defines the phrase "selected independently from the group selected from" which are improper Markush terminology in the absence of the phrase "selected from the group consisting of."

Claim 6, line 10 employs the improper Markush language "selected independently from."

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).